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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/852,547

05/10/2001

David A. Sirbasku

057041-000004

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03/11/2009

WOODARD, EMHARDT, MORIARTY, MCNETT & HENRY LLP
111 MONUMENT CIRCLE, SUITE 3700
INDIANAPOLIS, IN 46204-5137

EXAMINER

CANELLA, KAREN A

ART UNIT

PAPER NUMBER

1643

MAIL DATE

DELIVERY MODE

03/11/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 09/852,547</p>	<p>Applicant(s) SIRBASKU, DAVID A.</p>	
	<p>Examiner Karen A. Canella</p>	<p>Art Unit 1643</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 February 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: none.
Claim(s) objected to: none.
Claim(s) rejected: 95-109.
Claim(s) withdrawn from consideration: none.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Karen A Canella/
Primary Examiner, Art Unit 1643

Continuation of 5. Applicant's reply has overcome the following rejection(s): The provisional rejection of claims 98-101 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 34-43 of copending Application No. 09/852,958. .

Continuation of 11. does NOT place the application in condition for allowance because: Applicant argues that the specification includes several reference to the cell line GH4Cl, citing Table 1 after paragraph [0228] and figures 87-89. It is noted that the published application is not a substitute for the instant specification. There was no information regarding GH4Cl found after paragraph [0228] of the instant application. Figures 87-89 mention GH4Cl, but this mention is not equivalent to a written description of said cell line. Applicant has amended claim 95 to substitute "amount" in place of concentration. Applicant has submitted an amendments of claims 96 and 97 to specify that cell growth is inhibited by polymeric IgM rather than a mediator of immunoglobulin inhibition of steroid hormone responsive cell growth. Applicant argues that reference to the detection of a "mediator of immunoglobulin inhibition of steroid hormone responsive cell growth has been deleted. This is not found persuasive as claims 96 and 97 are still drawn to a method of detecting a mediator of immunoglobulin inhibition of steroid hormone responsive cell growth as the method objective. Applicant argues that the instant claims are supported by paragraphs [0241], [0549], [0579] and [0580], but no supporting disclosure was found therein. Applicant argues that a person of ordinary skill in the art would clearly recognize that significance of a comparison of the results of a negative control sample containing the substance to be assessed and also be capable of carrying out such a comparison without undue experimentation. Applicant is reminded that the rejections were not for lack of enablement based on undue experimentation, but lack of written description. Applicant is reminded that disclosure in an application that merely renders the later-claimed (by amendment) invention obvious is not sufficient to meet the written description requirement of 35 USC 112, first paragraph. *Lockwood v American Airlines, Inc.*, 41 USPQ.2d 1961 at 1966 (CAFC, 3/4/97).